

REMARKS

The Applicant wishes to thank the Examiner for discussing the request to demonstrate reasonable diligence in the preparation of and completion of filing the above referenced patent application during an Examiner Interview on August 17, 2006. In view of the resubmitted declaration and the below remarks, the Applicant asserts that reasonable diligence has been shown by the totality of the circumstances. Specifically, during the time period in question (i.e., November 11, 2000 to December 22, 2000) the responsibility for the preparation and filing of the Applicant's patent application was transferred from one law firm to another. Once transferred, significant revisions to the draft of the patent application continued up to the day the application was filed. Thus, the amount of time taken to prepare and file the Applicant's patent application was both understandable and reasonable. As a result, the Applicant respectfully asserts that the rejections to the pending claims are now moot, and the pending claims are in condition for allowance.

Declaration under 37 C.F.R. § 1.131

In the Office Action, each of the pending Claims 1-5, 7-11, 13, and 16-21 were rejected under 35 U.S.C. §103(a) as obvious in view of the combination of two patents, U.S. Patent No. 6,823,359 to et al. ("*Heidingsfeld*"), and U.S. Patent No. 6,157,943, to Meyer ("*Meyer*"). Previously submitted was a second declaration by the inventor, Stephen Charles Appling, made under 37 C.F.R. § 1.131 previously submitted. In that declaration, Mr. Appling establishes not only invention of the subject matter of the pending claims prior to the earliest filing date of the *Heidingsfeld* reference, but also reasonable diligence in preparing the 09/747,366 patent application ("the '366 application") for filing with the USPTO from a date just prior to the effective date of the *Heidingsfeld* reference until the filing of the '366 application (i.e., constructive reduction to practice).

However, the Examiner has indicated a need to further explain the attorney's diligence in preparing and filing the patent application and to further explain how the law firm of Jones & Askew, LLP listed on the original correspondence relate to the different law firms of Kilpatrick Stockton, LLP and Sutherland Asbill & Brennan, LLP cited in the subsequent correspondences

referenced in the declaration. As a result, the Applicant hereby resubmits the 37 CFR § 1.131 declaration with its exhibits now containing partially unredacted correspondences to provide further clarification regarding the actions taken by both the inventor and attorneys preparing the '366 application. For the reasons stated below, the Applicant asserts that reasonable diligence was undertaken by both the inventor and patent attorney in preparing and filing the pending patent application, and the transfer of files from the three referenced law firms adds to the reasonableness in the amount of time it took to complete and file the Applicant's pending application.

A. Explanation of Multiple Law Firms Involved in Preparation of the Application

In the Office Action dated June 15, 2006, the Examiner requested clarification as to the role of the three law firms referenced in the previously submitted 37 CFR § 1.131 declaration that were involved in the preparation of the Applicant's patent application. The first correspondence of September 8, 2000 was sent by the law firm of Jones & Askew, LLP. Around the same time the September 8, 2000 correspondence was sent, Jones & Askew merged with the law firm of Kilpatrick Stockton, LLP, which is listed on the correspondence of November 10, 2000. The attorney handling the preparation of the '366 application at the time was Mr. S. Craig Hemenway, who was listed on both the September 8, 2000 and November 10, 2000 correspondences. The fact that the same attorney sent both correspondences provides continuity between the two correspondences.

Further, several of the Jones & Askew attorneys left Jones & Askew around the time of the merger with Kilpatrick Stockton and joined the law firm of Sutherland Asbill & Brennan LLP. Mr. Hemenway was not one of them. As stated in paragraph 9 of the 37 CFR § 1.131 declaration, sometime between November 10, 2000 and the correspondence dated December 11, 2000, this file was transferred from Kilpatrick Stockton, LLP to Sutherland Asbill & Brennan, LLP at the request of the client. The transfer of this file with the application in draft form, as discussed below, is part of the understandable reason it took the time it did to complete and file the '366 patent application.

B. Resubmission of Partially Unredacted Correspondences

In a previous submission of the 37 CFR § 1.131 declaration, the correspondences between the inventor and his patent counsel at Sutherland Asbill & Brennan, LLP submitted as exhibits were heavily redacted to preserve the confidentiality of such communications and avoid any potential unintended and/or unnecessary waiver of the attorney client privilege. However, such redactions likely had the unintended consequence of calling into question the diligence of the both the inventor and patent counsel during the period between the letter correspondence of November 11, 2000 providing a draft of the Applicant's pending application to the inventor for his review and the filing of the '366 application on December 22, 2006.

To help clarify, these communications are now resubmitted with relevant portions now partially unredacted to better demonstrate what actions were being taken during the time between November 11, 2000 and December 22, 2000. However, to preserve the confidentiality of communications with counsel and prevent any potential unwanted waiver of the attorney-client privilege, some portions of these correspondences still remain redacted to provide no more information than is necessary to establish diligence from a date prior to the filing of *Heidingsfeld* on November 21, 2000 up to the filing of the '366 application on December 22, 2000.

As shown in the correspondence of November 10, 2000, the attorney, Mr. S. Craig Hemenway, asks that the inventor review and approve of the current version of the draft of the patent application and begin the process of completing formal documents such as the Inventor's Oath or Declaration and Assignment documents conveying ownership of the patent application to the inventor's employer Automated Logic Corporation. Further, the correspondence indicates that a second application was also being drafted at the same time as the preparation of the '366 application indicating that both the inventor and Mr. Hemenway had additional work to attend to during the preparation of the '366 application. Therefore, at the time of the draft of this letter, the inventor was asked to review and approve of both applications.

Further, as stated above, paragraph 9 of the inventor's 37 CFR § 1.131 declaration describes how sometime between November 10, 2000 and the correspondence dated December 11, 2000, the client file relating to the preparation of the '366 patent application were transferred

from Kilpatrick Stockton, LLP to Sutherland Asbill & Brennan, LLP at the request of the client.

The logistics of physically transferring a client's file from one law firm to another along with the various administrative tasks associated with the transfer of client files often takes several days, if not several weeks to complete. These administrative tasks include the original law firm's need to review and prepare the file for transfer with the appropriate instructions to the new law firm as well as physically transfer the file to the new law firm. Additionally, the new law firm must draft an engagement letter with the client and run a conflicts check which may take several days to clear, as the other attorneys of the firm must review the potential conflict and respond to the extent a conflict may exist. Further, the new law firm often opens new docketing numbers and creates a working file for the working attorney. Further, the new attorney must review the current status of the matter and become familiar with its status and content. It is also worth noting that the time period in question from mid-November to mid-December includes the Thanksgiving holiday of November 23, 2000.

In the partially unredacted correspondence of December 11, 2000 from Mr. Michael Pavento, a patent attorney at Sutherland Asbill & Brennan, LLP, Mr. Pavento apologizes for not being able to get the revised application (referred to in the correspondence as the "IFRAME" application) on the previous Friday as he had hoped and also indicates that his changes to the draft of the '366 patent application were "pretty significant." Such statements suggest that not only the application was not in yet in final form, but that Mr. Pavento was working on this matter well before December 11, 2000 (and at the very least was working on revising the draft of the '366 application on December 8, 2000). Further, the correspondence of December 11, 2000 references other patent application drafts, which were also in the drafting phase, indicating that both the inventor and Mr. Pavento had additional work and responsibilities to attend to besides the '366 application.

In the partially unredacted correspondences of December 22, 2000, both the attorney and the inventor transmitted their comments for the others review, both making their suggestions to modify particular areas of the draft of the '366 patent application. Mr. Pavento's email indicated that the application was revised per the inventors comments and more claims were added at the end of the application indicating that additional work and correspondence occurred

between Mr. Pavento and the inventor Stephen Appling. The email also asks that the inventor call him regarding the draft once the inventor has finished reviewing the application. This demonstrates that the referenced emails were not their only form of communication during the preparation of the patent application. Again, the emails referenced other patent applications, which were also being worked on by both the inventor and the attorney as part of their other responsibilities. At the end of the inventors correspondence, the inventor finally indicated that the application was a final form, specifically stating "Rest of it looks great." The application was then filed on that same day, December 22, 2000.

Conclusion

In summary, the redacted correspondences referenced in the 37 CFR § 1.131 declaration had the unintended consequence of conveying that the application was ready for filing on or about November 10, 2000, yet was not filed until December 22, 2000. However, as stated in paragraph 9 of the 1.131 declaration and indicated by the correspondences referenced in the declaration, the law firm handling the preparation of the patent application was changed sometime between the correspondence from Kilpatrick Stockton on November 10, 2000 and the correspondence from Sutherland Asbill & Brennan on December 11, 2000. Further, the partially unredacted correspondences, such as the correspondences of December 11, 2000 and December 22, 2000, indicated that additional “significant” revision and review of the draft of the patent application were being conducted by the attorney and inventor during that time period, which included the Thanksgiving holiday.

Given that during the time period in question (i.e., November 11, 2000 to December 22, 2000) the responsibility for the preparation and filing of the Applicant’s patent application was transferred from one law firm to another and the fact that “significant” revisions to the draft of the patent application continuing up to the day the application was filed, the amount of time taken to prepare and file the Applicant’s patent application was both understandable and reasonable. As a result, the Applicant respectfully asserts that the rejections to the pending claims are now moot, and the pending claims are in condition for allowance. As a result, the *Heidingsfeld* reference is not considered sufficient prior art to be used in combination with the *Meyer* reference to render the current claims unpatentable under 35 U.S.C. §103(a). For at least these reasons, the combination of *Heidingsfeld* and *Meyer* fails to render the pending claims unpatentable. Thus, the arguments presented in the Office Action are now moot. Therefore, the Applicant asserts that Claims 1-5, 7-11, 13, and 16-21 should be allowed.

The foregoing is submitted as a full and complete response to the Office Action. The Applicant requests that all pending claims be allowed because, as shown above, they are patentable over the art of record. It is therefore respectfully requested that a Notice of Allowance be issued. If there are any issues that can be resolved by a telephone conference or an Examiner’s Amendment, the Examiner is invited to call the undersigned attorney at (404) 853-

In re: Appling
Appl. No.: 09/747,366
Filed: December 22, 2000
Page 8 of 8

8253.

It is not believed that extensions of time or fees for addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



William T. Cook
Registration No. 58,072

SUTHERLAND ASBILL & BRENNAN, LLP
999 Peachtree Street, NE
Atlanta, Georgia 30309-3996
(404) 853-8253
(404) 853-8806 (fax)
SAB Docket No.: 15555-0020